

**REMARKS**

**A. Introduction**

The Office Action has been received and carefully considered. Claims 1-11, 13-16, 22-32, 34-46, 48-59, 61-71, 78-88 and 93-100 are pending in the present application. With this response, no amendment has been made to the present application. Applicant believes that the application is in condition for allowance and notice thereof is respectfully requested.

**B. The Rejection under 35 U.S.C. § 102(b)**

The Office Action rejects claims 1-11, 13-16 and 22-24 under 35 U.S.C. §102(b) as being anticipated by Marino *et al.* (US Patent 4,850,007, hereinafter "Marino"). These rejections are respectfully traversed as follows.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a *prima facie* case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." Id.

Claim 1 recites a method for providing directory assistance to a caller attempting to place a telephone call to an unavailable telephone number. The method comprises the steps of (i)

detecting a caller's telephone call to an unavailable number, (ii) intercepting the telephone call, (iii) providing at least one advertisement to the caller, and (iv) automatically routing the telephone call to a directory assistance service.

It is respectfully submitted that Marino does not disclose each and every element recited in claim 1 or other claims.

- (1) Marino does not disclose the step of "detecting a caller's telephone call to an unavailable number."

Marino discloses an economical telephone toll service in which:

"a telephone subscriber selects the economical service by, for example, sending an appropriate signal, and then dials his directory assistance call or other telephone toll call." (Col. 1, lines 41-44).

"After the caller's options are determined and typically before signaling for the call is commenced, a recorded-announcement of an aural or visual nature, or both, is connected to the subscriber's line, the announcement consisting of at least one advertisement." (Col. 1, lines 44-49).

As can be seen, Marino requires that a subscriber take affirmative action to select the telephone toll service. In other words, the subscriber's connection to the economical service is contingent upon the transmission of an appropriate signal. There is no teaching in Marino that the economical service is capable of detecting the subscriber's call to an unavailable number. In fact, Marino does not even mention the term "unavailable telephone number" or its variants.

The only detection function referenced in Marino is found in the following passage.

"The internal connections of the system are, in more detail, the following. The line from local telephone station 11 will be routed, through portions of switching elements 15, to the directory assistant module of the local switching system 12 if that is the nature of the customer's request, and in general, this may have been reached by dialing 411 or by dialing 555-1212 after the appropriate area code. Alternatively, the switching system 12 may also detect, depending on the prefixes which the customers dial, that the customer is seeking certain information services, such as time or weather. Request for

either of these services may be an occasion [sic] to offer a subscriber a reduced rate or a credit in return for listening to, or watching, advertising messages from advertising message system 13.” (Col. 3, lines 1-15)(emphasis added).

The quoted passage discloses at best a function of determining, based on telephone number prefixes, what type of information services the customer is seeking. It does not specifically teach the detection of a telephone call to an unavailable number.

In fact, it would be unnecessary for Marino’s system to detect a telephone call to an unavailable number. According to Marino, “a telephone subscriber selects the economical service ... and then dials his directory assistance call or other telephone toll call.” (Col. 1, lines 41-44). And the economical service is provided “after the caller’s options are determined and typically before signaling for the call is commenced” (col. 1, lines 44-49), at which point “the local telephone subscriber is not in contact with the larger telephone network.” (Col. 3, lines 39-41). Marino’s advertising message system does not perform any toll switching function of the telephone network; it simply delays the processing of a dial toll call. Thus, the availability of the dialed telephone number is irrelevant to the operation of Marino’s system. There is no need for Marino’s system to detect an erroneous call at all.

Therefore, Marino does not disclose “*detecting a caller’s telephone call to an unavailable number*” as recited in claim 1.

(2) Marino does not disclose the step of “*intercepting the telephone call.*”

The present application discloses intercepting a telephone call dialed to an unavailable number. Marino requires a caller to affirmatively and voluntarily select the economical service. Only upon such a selection is an advertising announcement connected to the subscriber’s line. Otherwise, advertising is not provided to the user. “After the initial delay, usually after the advertising announcement is completed, the toll call and/or directory assistance call is processed

as usual ...” (Abstract). Thus, a user in Marino’s system does not experience an intercept but rather **a voluntary delay** after which the telephone call is **routed as dialed**.

- (3) Marino does not disclose the step of “automatically routing the telephone call to a directory assistance service.”

The present application discloses **automatic routing** of a call made to an unavailable number. In Marino, although a user’s call may be routed to a directory assistance service as shown in FIG. 1, such routing is not done **automatically**.

“The line from local telephone station 11 will be routed, through portions of switching elements 15, to the directory assistant module of the local switching system 12 **if that is the nature of the customer’s request**...” (Col. 3, lines 2-6)(emphasis added).

That is, the telephone call is routed to a directory assistance service **only upon the customer’s request**. Therefore, Marino does not disclose an automatic function to route the telephone call to a directory assistance service as claimed in the present application.

For the foregoing reasons, Marino does not disclose each and every element in claim 1 of the present application. Since claims 2-11, 13-16, and 22-24 all depend from claim 1, they are not anticipated by Marino for at least the same reasons. Applicant respectfully requests that the rejection of claims 1-11, 13-16 and 22-24 under 35 U.S.C. §102(b) be withdrawn.

**C. The Rejection under 35 U.S.C. § 103(a)**

The Office Action also rejects claims 25-32, 34-46, 48-59, 61-71, 78-88 and 93-100 under 35 U.S.C. §103(a) as being unpatentable over Marino in view of Bilder (US Patent 6,400,804, hereinafter “Bilder”). These rejections are respectfully traversed as follows.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Further, as stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

(1) Marino, Bilder or Their Combination Do Not Teach or Suggest All the Elements of the Claimed Invention.

As stated above and conceded by the Office Action, Marino does not teach or suggest the unavailability aspect which is recited in all pending claims of the present application.

Contrary to the Office Action's allegation, Bilder also does not teach or suggest the unavailability aspect. Applicant discloses:

The term "available telephone number" and its variants, as used herein, are intended to refer to a telephone number that is in service and to which calls can successfully be placed. Conversely, the term "unavailable telephone number" and its variants, as used herein, are intended to refer to a telephone number that is not available to the caller for whatever reason and therefore a call placed to the telephone number cannot be completed as dialed. An attempted telephone call placed to an unavailable telephone number is herein referred to as an "erroneous call." Likewise, a caller attempting to place an erroneous call is herein referred to as an "erroneous caller." (Page 6, lines 13-20).

On the other hand, Bilder discloses "an on-hold activity selection device and method that permits a party placed on hold to select from a repertoire of activities." (Col. 1, lines 29-32).

Bilder does not mention any "unavailability aspect" other than the on-hold condition.

An on-hold condition is a completely different issue from an erroneous-call condition. It is well known that a caller can be placed on hold only if the call has been successfully connected as dialed. Yet an erroneous call is one placed to an unavailable telephone number. Although the effect of both conditions may appear similar to the caller, the underlying processes are quite different. For example, the on-hold condition in Bilder is detected locally by either an on-hold activity selection device coupled to a private branch exchange (PBX) (col. 3, lines 21-23), or by a call-receiving terminal (col. 3, lines 30-34). In contrast, an erroneous-call condition in the present invention is detected at a central office (CO) (page 8, lines 5-8). For a caller placed on hold, it may be only a matter of time before the call is answered. However, for a caller who dialed an unavailable number, there may not be anyone to answer the call. Such a caller would have a need for directory assistance while an on-hold caller does not. Since on-hold condition is a completely different issue, Bilder does not disclose the unavailability aspect as recited in the present application.

Furthermore, Marino, Bilder or their combination do not teach or suggest automatically routing a call to a directory assistance service as recited in all the pending claims of the present application. As stated above, Marino does not disclose the automatic routing function. As for Bilder, since it is only concerned with a caller placed on hold, it would be unnecessary and undesirable to re-direct the caller to a directory assistance service. Indeed, Bilder makes no reference to a directory assistance service or the like throughout its description.

For at least these reasons, Marino and Bilder fail to teach or suggest all the elements of the claimed invention.

(2) There is No Suggestion or Motivation to Combine Marino and Bilder.

The Office Action fails to suggest an objective reason why one of ordinary skill in the art would be led to combine Marino and Bilder. The Office Action asserts that it would be obvious to incorporate the unavailability aspect and the prompting aspect of Bilder into Marino “as another way of providing advertising to a customer.” (Office Action, page 3). However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). It is respectfully submitted that neither Marino nor Bilder offers any suggestion or motivation for their combination.

In view of the foregoing reasons, claims 26, 41, 57, 78, 79 and all the claims dependent therefrom are patentable over Marino and Bilder. Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn.

**D. Conclusion**

For at least the reasons provided above, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and allowance of the pending claims are respectfully solicited.


Should the Examiner require any further clarification, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

In the event any additional fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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By:

  
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under 37 C.F.R. § 10.9(b)

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